

Applicant still asserts that Claims 1-40 are all part of a single invention. The public good is not served by issuing two or more patents from the application. However, to advance the prosecution of this Applicant affirms the election of Group I, with traverse.

The non-elected claims are cancelled without prejudice or disclaimer.

Applicant reserves the right to return to this issue when any pending claims are allowed. Alternatively, Applicant reserves the right to file a divisional application as needed to preserve rights in the non-elected claims.

REJECTION PURSUANT TO 35 U.S.C. 101: PROVISIONAL REJECTION

When claims are allowed in the present application or in U.S. Serial Nos. 328,181 or 346,064, Applicant will take steps to obviate this provisional rejection.

REJECTION PURSUANT TO 35 U.S.C. 101:
NON-STATUTORY SUBJECT MATTER

The Examiner argues that the growth factor has the same characteristics and utility as the natural growth factor.

Applicant respectfully traverses this rejection.

The claims as presently amended claim a growth factor in substantially pure and isolated form. The isolation procedures are described in the application. This is not the same composition as found in nature.

Applicant argues that this rejection has overcome Reconsideration and withdrawal of the rejection is respectfully requested.

REJECTION OF CLAIMS 1-5, 12-25, 33-36 AND 38-40
PURSUANT TO 35 U.S.C. 112: FIRST PARAGRAPH

The Examiner argues that the application and claims fail to enable one of skill in the art to practice the invention. The

Examiner cites the letter sent by Dr. D. Gospodarowicz to this case, U.S. Serial No. 346,165.

Applicant respectfully traverses this rejection.

Applicant filed in USSN 328,181 on November 29, 1990 a petition pursuant to 37 C.F.R. 1.48(a) and/or (c) to add Dr. Napoleone Ferrara to the present U.S. patent application.

Supporting documents included:

1. A declaration by Dr. D. Gospodarowicz that Dr. N. Ferrara is an inventor of claims of the present application signed May 24, 1989.
2. A Declaration by Dr. N. Ferrara that he believes he is an inventor of claims of the present patent application, signed May 10, 1989.
3. An Affidavit by Dr. J. Plouet a post-doctoral student in Dr. Gospodarowicz's laboratory at this time signed May 31, 1989.
4. A declaration by Howard M. Peters the undersigned attorney, signed November 26, 1990.
5. A declaration by Laurence C. Bonar assenting for the Assignee to the addition of Dr. N. Ferrara as a co-inventor, signed November 27, 1990.

The Examiner is directed to review this case and these documents regarding this rejection.

Further, it is my understanding that the University of California at San Francisco, performed a scientific and legal investigation of the allegations made by Dr. Gospodarowicz in his letter filed in this pending application. The University concluded that Dr. D. Gospodarowicz's allegations were made without merit.

It is also my understanding that Genentech, Inc. of South San Francisco, CA performed a legal and scientific investigation

regarding the allegations raised by Dr. D. Gospodarowicz in his letter filed in this pending application. Genentech, Inc. also concluded that Dr. D. Gospodarowicz's allegations were made without merit.

Applicant requests the Examiner provide specific guidance in the next Official Action if more detailed information is needed.

Reconsideration and withdrawal of this rejection is respectfully requested.

REJECTION OF CLAIMS 19, 20 AND 40 UNDER 35 U.S.C. 112

The Examiner argues that Applicant needs description of the recombinant DNA methods.

Applicant argues that in view of the state of the art, one of ordinary skill would be able to obtain the factor without undue experimentation.

REJECTION OF CLAIMS 1, 2, 15, 21-25, 36 AND 40
UNDER 35 U.S.C. 112

The Examiner argues that certain claims appear to be identical.

Applicant respectfully traverses this rejection.

Claim 35 is now amended to depend on Claim 34. Applicant plans to cancel identical claims in the next response.

REJECTION OF CLAIMS 1-5, 12-25, 33-36 and 38-40
UNDER 35 U.S.C. 102(b) OR ALTERNATIVELY UNDER 35 U.S.C. 103

The Examiner asserts that the claims are anticipated or obvious in view of W.H. Burgess et al, The Journal of Biological Chemistry, Vol. 260, 11389 (1985), hereafter Burgess et al. and also in J.A. Winkles, et al., Proceeding the National Academy of Sciences, Vol. 84, 7124 (1987), hereafter Winkles et al.

Applicant respectfully traverses these rejections.

Applicant argues that Burgess et al. describe an acidic form of FGF which is significantly different from the endothelial cell

growth factor as presently claimed. They do not describe FSdGF as presently claimed.

Applicant argues that Winkles et al. also describes an acidic form of FGF which is significantly different from the endothelial cell growth factor as presently claimed. Winkles et al. does not describe FSdGF as presently claimed.

Applicant reserves the right to submit comparative data if such is needed.

Reconsideration and withdrawal of these rejections are respectfully requested.

SUMMARY

On the basis of the above amendments and remarks, Applicant argues that the Examiner's rejections have been overcome. Accordingly, the present claims are of a form of a scope for allowance. Prompt notification thereof is respectfully requested.

If the Examiner has any questions or comments, she is encouraged to call the undersigned at 415-421-2674. Applicant will be pleased to present any documents which will advance the application to issue.

Respectfully submitted,



HOWARD M. PETERS (Reg. No. 29,202)

for

PHILLIPS, MOORE, LEMPPIO & FINLEY

177 Post Street, Suite 800

San Francisco, California 94108

Attorneys for Applicant

HMPeters:cl

Tel: (415) 421-2674

Fax: (415) 421-1663

Enclosures:

Petition for Extension of Time and Fee

UC#4\479.58-1\amendment.2\11\30